

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. Notice of references cited (PTO Form 892)

In reference to the applicant's reply dated August 13, 2009, the applicant reminds the examiner that U.S. patent 5,169,155 (*Soules*) applied in the 35 U.S.C. 103 rejection of the Office Action dated May 13, 2008 is not listed on the form 892. Instead, it appears that cited U.S. patent 6,169,155 (*Alvarez*) was inadvertently included instead of the Soules patent.

Applicant respectfully requests that U.S. patent 5,169,155 (*Soules*) be added to the PTO form 892, and a correction be made with regard to the listing of U.S. patent 6,169,155 (*Alvarez*).

2. In the claims

Claim 1 is amended to recite that the first feature substance is formed by at least one of a luminescent substance and a mixture of luminescent substances, having a complex spectral distribution, wherein the spectral distribution itself forms a coding. Support for this amendatory language is found in the written description at least in paragraphs [0015] and [0042].

Claims 4 and 8 have been amended in view of the amendment to claim 1.

Claim 18, which recites a method for producing a value document, has been amended so that it recites the step of forming the first feature substance in the manner prescribed by amended claim 1.

Claim 22, which recites a method for checking the authenticity of a value document, has been amended to include the step of checking the authenticity of the value document on the basis of the coding formed by said spectral distribution itself when it is selected to use the first feature substance to check the authenticity of the value document.

Support for this amendatory language is likewise found in the written description at least in paragraphs [0015] and [0042].

Claim 22 is amended to incorporate the value document of claim 1.

Additional minor amendments are made to the claims which are self-evident.

It is submitted that the amendment to the claims is fully supported by the written description, and hence no new matter is entered by the application.

Entry of the Amendment to the claims is respectfully requested in the next Office Action.

3. Rejection of claims 1, 4-11, 13, 16-19, 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,506,476 (*Kaule*) in view of U.S. patent 4,455,039 (*Weitzen*)

Reconsideration of this rejection is respectfully requested in view of the amendment to claims 1 and 18, and the following observations on how the proposed combination of *Kaule* and *Weitzen* fails to render the pending claims *prima facie* obvious. Claims 1, 4-11, 13, 16, 17, 30 and 31 are at least patentable in view of their dependency from independent claim 1.

In observing claim 1, the claim is drawn to a value document having at least two different feature substances for checking the document, wherein first and second feature substances form mutually independent codings.

As described in the specification at paragraphs [0009] and [0010], this arrangement allows a first group of users to use the first feature substance for authenticity checking and value recognition and a second group of users to use the second feature substance for authenticity checking and value recognition. With this arrangement, knowledge of the procedure of one group does not reveal the substances and methods used for authenticity checking and value recognition by another group.

None of the cited references, whether considered individually or collectively, contemplate providing at least two different feature substances on the same value document for checking the value document, wherein first and second feature substances form mutually independent codings. As such, the proposed combination of *Kaule* and *Weitzen* fails to render independent claim 1 *prima facie* obvious.

Both *Kaule* and *Weitzen* only describe one feature substance on the substrates described therein, and such teachings are further described in the rejection. The rejection appears to reason that because *Kaule* teaches the use of one feature substance (feature substance A) and *Weitzen* teaches the use of another feature substance (feature substance B), basically reaching the conclusion it would be obvious to add feature substance A plus feature substance B on a value document. The applicant respectfully disagrees that the skilled person would reach such a conclusion from the combined teachings of *Kaule* and *Weitzen*.

It will be noted that the bands (3), (4) and (5) of *Weitzen* combine to form a single bar code (1:37-41; 3:58-61), and are not independent from one another.

Nowhere is there any understanding among *Kaule* and *Weitzen* of providing a value document with two separate feature substances. Furthermore, there is no understanding that the two separate feature substances are mutually independent from one another.

The rejection fails to provide the factual underpinnings which demonstrate that it would have been obvious to place the codings of *Kaule* and *Weitzen* on a single value document substrate. Instead, the rejection only provides reasoning derived from *Weitzen* that a coding is provided on a value document to make it more difficult to counterfeit (1:31-33). Presumably, both the single coatings of *Kaule* and *Weitzen* make the value documents thereof more difficult to counterfeit, yet the identified passage in *Weitzen* or any other teaching among *Kaule* and *Weitzen* does not convey to skilled person the notion of two different feature substances each providing a coding independent from one another.

Accordingly, it is submitted that the skilled person would not understand from *Kaule* and *Weitzen* the notion of the value document according to claim 1 having two feature substances forming independent codings.

As indicated above, claim 1 has been amended to recite that the first feature substance is formed by at least one of a luminescent substance and a mixture of luminescent substances, having a complex spectral distribution, wherein the spectral distribution itself forms a coding.

Nowhere is there any understanding in the teachings of *Kaule* and *Weitzen* of using a feature substance having the characteristics of the first feature substance in amended claim 1.

Kaule does not disclose the use of a mixture of luminescent substances, and only describes that different substances can be used. There is no understanding of the luminescent substances having a complex spectral distribution which forms a coding itself.

Weitzen only teaches that one of the coding may be formed by a luminescent substance with the various bands combining to form a single code.

Accordingly, the combination of *Kaule* and *Weitzen* fails to disclose or suggest the value document according to amended claim 1. Claim 1 is therefore patentable. The claims dependent from claim 1 are at least patentable based on their dependency from claim 1 and their individually recited features.

Amended claim 18 describes a method for forming a value document having the characteristics of the value document of claim 1. The particular steps required by amended claim 18 would likewise not be understood by the combination of *Kaule* and *Weitzen*.

From the foregoing, amended claim 18 is therefore patentable. The claims dependent from claim 18 are at least patentable based on their dependency from claim 18 and their individually recited features.

Withdrawal of this rejection is respectfully requested.

4. Rejection of claims 2, 3 and 21-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 6,506,476 (*Kaule*) in view of U.S. patent 4,455,039 (*Weitzen*) and further in view of U.S. patent 6,491,324 (*Schmitz*)

Reconsideration of this rejection is respectfully requested in light of the observations noted above with respect to independent claim 1, from which claims 2 and 3 depend, independent claim 18 from which claim 21 depends, and the amendment to claim 22 from which depend claims 23-29 depend. The foregoing observations on claims 1 and 18 apply equally as well to claim 22.

It is submitted that *Schmitz* does not make up for the basic shortcomings of *Kaule* and *Weitzen*. Thus, claims 2, 3 and 21-29 are patentable. Accordingly, withdrawal of this rejection is respectfully requested.

5. Co-pending applications

The applicant informs the examiner that this application is related to co-pending U.S. applications 10/574,838, 10/575,074, 10/575,080 and 10/575,079. An Office Action has already been issued in U.S. applications 10/575,074 and 10/575,079.

6. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

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